

PTO/SB/30 (01-08)

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Request for Continued Examination (RCE) Transmittal

Address to:
Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Application Number	10/553,132
Filing Date	October 14, 2005
First Named Inventor	Raymond Hesline
Art Unit	2872
Examiner Name	Derek S. Chapel
Attorney Docket Number	

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

- Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).
 - ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
 - ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
 - ☐ Other _____
 - ☒ Enclosed
 - ☒ Amendment/Reply
 - ☐ Affidavit(s)/Declaration(s)
 - ☐ Information Disclosure Statement (IDS)
 - ☐ Other _____
- Miscellaneous**
 - ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(l) required)
 - ☐ Other _____
- Fees** The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed. The Director is hereby authorized to charge the following fees, any underpayment of fees, or credit any overpayments, to Deposit Account No. _____. I have enclosed a duplicate copy of this sheet.
 - ☐ RCE fee required under 37 CFR 1.17(e)
 - ☐ Extension of time fee (37 CFR 1.136 and 1.17)
 - ☐ Other _____
 - ☐ Check in the amount of \$ _____ enclosed
 - ☒ Payment by credit card (Form PTO-2038 enclosed)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Signature	<i>R. Hesline</i>	Date	October 22, 2009
Name (Print/Type)	Raymond Hesline	Registration No.	

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Signature	<i>R. Hesline</i>	Date	October 22, 2009
Name (Print/Type)	Raymond Hesline		

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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10/22/2009 HMARZ11 00000051 10553132

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PAGE 7/8 * RCVD AT 10/22/2009 8:26:38 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/0 * DNIS:2738300 * CSID:+61 2 9918 0002 * DURATION (mm:ss):04:16

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INVENTOR: RAYMOND HESLINE
SERIAL NUMBER: 10/553,132
FILED: 10/14/2005
GROUP ART UNIT: 2872
EXAMINER: DEREK S. CHAPEL
TITLE: OPTICAL ISOLATOR, ATTENUATOR, CIRCULATOR AND SWITCH

By Facsimile 571-273-8300

October 22, 2009

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
United States of America

Dear Sir,

Response after Notice of Panel Decision
from Pre-Appeal Brief Review mailed September 22, 2009

As USPTO has rescinded Final Rule 114, response will be a request for continued examination. An appeal brief will not be filed.

35 USC § 103(a)

To address objection concerning obviousness:-

1. A declaration is attached stating that the inventor of US Pat No. 5,864,428 is the inventor of present patent application 10/553,132.
2. In the specification of the present application, reference is made to US Pat No. 5,864,428. Figure 2 of the present application is an embodiment of US Pat No. 5,864,428 and is labeled "prior art". Prior art of US Pat No. 5,864,428 cited in the present application is work of the applicant and not work of another.

Serial No. 10/553,132

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Art Unit 2872

Response after Notice of Panel Decision from Pre-Appeal Brief Review

The US Manual of Patent Examining Procedure, Eighth Edition, Fifth Revision (August 2006), Section 2129, Admissions of Prior Art, reads:

1. Admissions by Applicant Constitute Prior Art

A statement by an applicant during prosecution identifying the work of another as "prior art" is an admission that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). However, even if labeled as "prior art," the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories. *Id.*; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984) ("[W]here the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work.").

Consequently, the examiner must determine whether the subject matter identified as "prior art" is applicant's own work, or the work of another. In the absence of another credible explanation, examiners should treat such subject matter as the work of another.

Applicant argues that objections by the examiner citing US Pat No. 5,864,428 are overcome as objections are based upon the applicant's own work and not on the work of another.